

RECEIVED
CENTRAL FAX CENTER

Appln. S.N. 09/997,761
Amtd. dated September 29, 2006
Reply to Office Action of June 30, 2006
Docket No. GP-301187-OST-ALS

7

SEP 29 2006

REMARKS

The Office Action of June 30, 2006 has been received and carefully reviewed. It is submitted that, by this Amendment, all bases of rejection are traversed and overcome. Upon entry of this Amendment, claims 1-30 remain in the application. Reconsideration of the claims is respectfully requested.

Claims 1-6, 8-16, 18-25 and 27-30 stand rejected under 35 USC 102(e) as being anticipated by Bhatia et al (US Publication No. 2002/0090932). The Examiner stated that Bhatia discloses the method, system and computer medium of claims 1, 12 and 20, respectively. The Examiner concluded that Bhatia teaches 1) receiving and updating a mobile subscriber location; 2) determining a real-time subscriber delivery-enabling information based on the service request and the location; 3) customizing (i.e., configuring) the service corresponding to the service request; and 4) providing the customer information to the subscriber. The Examiner has interpreted Applicant's claimed service management subsystem to be equivalent to the collective elements of the content provider and the B2B engine described by Bhatia.

Applicant submits that Bhatia clearly distinguishes the B2B engine from the content provider. It is further submitted that Bhatia neither teaches nor suggests that the B2B engine and the content provider are, or should be, part of a single management system. Bhatia specifically states (at Col. 4, lines 1-5) that, "[T]he B2B engine 210, upon receipt of the real-time status information, forwards the real-time data to the content providers, thereby permitting customization according to the respective user's real-time situation and preferences." This statement clearly indicates that customization of the service (i.e., the information provided by the content provider) occurs *after* the real time information is customized by the B2B Engine and sent to the content provider.

The B2B engine and content provider of Bhatia have different functions, and the reference provides no motivation to combine the engine and provider into a single system that is capable of performing the different functions. In fact, it is submitted that Bhatia *teaches away* from such a combination when he states that the function of the B2B engine is to

RECEIVED
CENTRAL FAX CENTER

Appln. S.N. 09/997,761
 Amdt. dated September 29, 2006
 Reply to Office Action of June 30, 2006
 Docket No. GP-301187-OST-ALS

8

SEP 29 2006

maintain the real-time information exchange between the mobile operator and the respective content providers (see paragraph [0047]). This is further supported by paragraphs [0071] et seq. (including paragraph [0106]), which describes how the B2B engine updates the end user's information, forwards the revised information to the content provider/portal, and then bills the content provider/portal for its access to the real-time information. It is submitted that if the B2B engine of Bhatia were combined into a single system with the content provider of Bhatia, the stated purpose of the B2B engine (i.e., to maintain the real-time information exchange between the mobile operator and the respective content providers) would be destroyed. As such, Applicant's strongly disagree that Bhatia teaches or even suggests a combined B2B and content provider management system.

Applicant respectfully submits that the Examiner is using impermissible hindsight from Applicant's disclosure in order to assume that Bhatia teaches or even suggests a single system capable of performing the functions of the B2B engine and the content provider.

The Federal Circuit has spoken to the issue of impermissible hindsight on numerous occasions. In *In re David H. Fine*, 837 F.2d 1071, 5 U.S.P.Q. (BNA) 1596 (Fed. Cir. 1988), the court stated:

To reach a proper conclusion under § 103, the decisionmaker must step backward in time and into the shoes worn by [a person having ordinary skill in the art] when the invention was unknown and just before it was made. In light of *all* the evidence, the decisionmaker must then determine whether . . . the claimed invention as a whole would have been obvious at *that* time to *that* person. 35 U.S.C. § 103. The answer to that question partakes more of the nature of law than of fact, for it is an ultimate conclusion based on a foundation formed of all the probative facts. (emphasis in original) *Id.* at 1073-74, quoting *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1566 (Fed. Cir. 1987)

Further, the *Fine* court stated at 1075:

Because neither Warnick nor Eads, alone or in combination, suggests the claimed invention, the Board erred in affirming the Examiner's conclusion that it would have been obvious to substitute the Warnick nitric oxide detector for the Eads sulfur dioxide detector in the Eads system. *ACS Hosp. Sys.*, 732 F.2d

Appln. S.N. 09/997,761
 Amdt. dated September 29, 2006
 Reply to Office Action of June 30, 2006
 Docket No. GP-301187-OST-ALS

9

at 1575-77, 221 USPQ at 931-33. The Eads and Warnick references disclose, at most, that one skilled in the art might find it obvious to try the claimed invention. But whether a particular combination might be "obvious to try" is not a legitimate test of patentability. [references omitted] (emphasis added)

The first quote above from the *Fine* court makes it clear that the Examiner must "step backward in time" to just before the present invention was made, and look at Bhatia without knowledge gleaned from Applicant's disclosure. If the Examiner did this, in light of the detailed discussion above of what the skilled artisan would glean from the reference, he would come to the conclusion that the reference does not speak to the issue of a single management system at all.

Applicant's claims recite that the service request and vehicle location (i.e., real-time information) is received, and the service configuration takes place at the service management subsystem. In sharp contrast to the teaching of Bhatia, Applicant's invention as defined in claims 1, 12 and 20 has a single entity processing both sets of information (i.e., real-time and service). As it is submitted that Bhatia does not teach or suggest a single system, Applicant respectfully submits that his invention as defined in claims 1, 12 and 20, and those claims depending ultimately therefrom is not anticipated, taught, or rendered obvious by Bhatia, either alone or in combination, and patentably defines over the art of record.

Claims 7, 17 and 26 stand rejected under 35 USC 103(a) as being unpatentable over Bhatia et al. in view of Doi et al (US Publication No. 2001/0014911). The Examiner stated that Bhatia does not disclose configuring a vehicle communication component in the vehicle based on delivery-enabling information. The Examiner went on to state that Doi teaches a mobile terminal with a dynamic user profile memory. The Examiner concluded that one skilled in the art would have combined the references to obtain a system, method, and medium having the flexibility to allow different users to use the vehicle and change his/her preferences.

Assuming *arguendo* that one skilled in the art would combine the references, Applicant submits that such a combination would not render obvious his invention as defined

RECEIVED
CENTRAL FAX CENTER

Appln. S.N. 09/997,761
Amdt. dated September 29, 2006
Reply to Office Action of June 30, 2006
Docket No. GP-301187-OST-ALS

10

SEP 29 2006

in claims 1, 12 and 20. As previously stated, Bhatia does not teach or suggest a combined B2B engine-content provider system. This is in sharp contrast to Applicant's invention as defined in claims 1, 12 and 20, from which claims 7, 17 and 26 respectively depend. As such, it is submitted that the combination of the references does not render obvious Applicant's invention as defined in these claims.

In summary, claims 1-30 remain in the application. It is submitted that, through this amendment, Applicant's invention as set forth in these claims is in a condition suitable for allowance.

Further and favorable consideration is requested. If the Examiner believes it would expedite prosecution of the above-identified application, the Examiner is cordially invited to contact Applicants' Attorney at the below-listed telephone number.

Respectfully submitted,

DIERKER & ASSOCIATES, P.C.



Julia Church Dierker
Attorney for Applicants
Registration No. 33368
(248) 649-9900, ext. 25
juliad@troypatent.com

3331 West Big Beaver Rd., Suite 109
Troy, Michigan 48084-2813
Dated: September 29, 2006
JCD/JRK/jrk